

ESTTA Tracking number: **ESTTA591547**

Filing date: **03/10/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Emitec Gesellschaft fur Emissionstechnologie MBH
Granted to Date of previous extension	03/09/2014
Address	Hauptstrasse 128 Lohmar, D-53797 GERMANY
Attorney information	Marie-Anne Mastrovito Abelman Frayne & Schwab 666 Third Avenue New York, NY 10017 UNITED STATES mamastrovito@lawabel.com

Applicant Information

Application No	85912789	Publication date	09/10/2013
Opposition Filing Date	03/10/2014	Opposition Period Ends	03/09/2014
Applicant	EMIT Technologies, Inc. 772 Airfield Lane Sheridan, WY 82801 WY		

Goods/Services Affected by Opposition

Class 007. First Use: 2000/11/17 First Use In Commerce: 2001/02/13 All goods and services in the class are opposed, namely: Catalyst products, namely, catalytic converters, catalyst housings and combination catalyst/silencers for fuel engines
Class 009. First Use: 2001/05/04 First Use In Commerce: 2001/07/18 All goods and services in the class are opposed, namely: Air-fuel ratio controllers and monitors for use with fuel engines
Class 037. First Use: 2001/05/00 First Use In Commerce: 2002/12/03 All goods and services in the class are opposed, namely: Catalyst installation and maintenance services in the natural gas industry
Class 041. First Use: 2001/06/00 First Use In Commerce: 2007/11/29 All goods and services in the class are opposed, namely: Educational services, namely, providing training programs in the field of emissions mitigation in the natural gas industry

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1447143	Application Date	09/30/1986
Registration Date	07/14/1987	Foreign Priority Date	04/07/1986
Word Mark	EMITEC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 0 First Use In Commerce: 0 CATALYTIC CONVERTERS AND MOUNTING UNITSFOR INTERNAL COMBUSTION ENGINES FOR INDUSTRIAL AND AGRICULTURAL USE AND FOR NON-LAND VEHICLES Class 012. First use: First Use: 0 First Use In Commerce: 0 CATALYTIC CONVERTERS AND MOUNTING UNITSFOR INTERNAL COMBUSTION ENGINES FOR LAND VEHICLES		

Attachments	EMITEC NOTICE OF OPPOSITION.pdf(296025 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/MAM/
Name	Marie-Anne Mastrovito
Date	03/10/2014

In the Matter Of: Trademark Application Nos. 85/912789 for the mark EMIT; published September 10, 2013;

Opposition No.

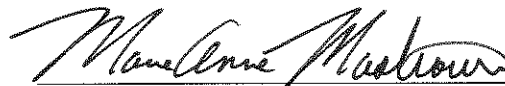
1. On April 23, 2013, Applicant, Emit Technologies Inc., filed an application for registration of the mark EMIT (hereinafter, "Applicant's Mark"). As published the application covers "catalyst products, namely, catalytic converters, catalyst housings and combination catalyst/silencers for fuel engines," in Class 7, "air-fuel ratio controllers and monitors for use with fuel engines," in Class 9, "catalyst installation and maintenance services in the natural gas industry," in Class 37 and "educational services, namely, providing training programs in the field of emissions mitigation in the natural gas industry," in Class 41 (hereinafter, "Applicant's Goods and Services").
2. The Applicant's application is based on an alleged use of the mark in commerce under Section 1(a) of the Trademark Act, and the earliest date of first use claimed in the application is November 17, 2000 which is claimed as the date of first use of the goods falling in Class 7.

3. Opposer is the owner of all right, title and interest to the trademark and tradename EMITEC (hereinafter, "Opposer's Mark") in connection with catalytic converters and mounting units for internal combustion engines and related services (hereinafter, "Opposer's Goods and Services"). Opposer began using Opposer's Mark in U.S. commerce over 20 years ago and the mark is still in use.
4. Opposer also is the owner of Registration No.1,447,143 (hereinafter, "Opposer's Registration") for the word mark EMITEC. Opposer's Registration issued July 14, 1987 and is incontestable. The good covered by said registration are "catalytic converters and mounting units for internal combustion engines for industrial and agricultural use and for non-land vehicles," in Class 7 and "catalytic converters and mounting units for internal combustion engines for land vehicles, " in Class 12.
5. On information and belief, Opposer's first use of Opposer's Mark in U.S. commerce in connection with Opposer's Goods and Services, preceded the filing date of Applicant's Application and any use which Applicant may have made of Applicant's Mark.
6. On information and belief, the filing date of the application underlying the Opposer's Registration precedes any use which Applicant may have made of Applicant's Mark.
7. Applicant's Mark is highly similar to Opposer's Mark in appearance, sound and commercial impression. Applicant has merely removed the letters EC from the end of the Opposer's Mark.
8. Applicant's Goods and Services as recited in Applicant's Application directly overlap with and are very closely related to the goods recited in Opposer's Registration and the goods and services with which Opposer has used Opposer's Mark.

9. The goods of Applicant and Opposer will travel in the same channels of trade.
10. Registration of Applicant's Mark is likely to cause confusion, mistake, or deception of purchasers as to the source of Applicant's Goods and Services, and is likely to falsely suggest a common association, sponsorship or origin of said goods and services between Applicant and Opposer, all to Opposer's irreparable damage and injury.
11. Applicant's Mark should be precluded from registration under Sections 2(d) of the Trademark Act because it so resembles a trademark previously used and registered by Opposer and not abandoned as to be likely when used on or in connection with the goods and services of the Applicant to cause confusion, to cause mistake, or to deceive.
12. Applicant's registration of Applicant's Marks will creates a cloud on Opposer's superior right to use Opposer's Mark and causes damage to the goodwill associated with this mark.

WHEREFORE, Opposer believes that it has a real interest in this proceeding and will be irreparably damaged by the registration of the Applicant's Marks, and respectfully requests that the Board sustain this action.

Respectfully submitted,



MARIE-ANNE MASTROVITO
LAWRENCE E. ABELMAN

ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE
NEW YORK, NEW YORK 10017
(212) 949-9022

Date: March 10, 2014

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid this 10th day of March, 2014 upon the following:

Joel D. Leviton, Esq.
Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, Minnesota 55402


MARIE ANNE MASTROVITO

Generated on: This page was generated by TSDR on 2014-03-10 13:30:16 EDT

Mark: EMITEC

US Serial Number: 73623233
US Registration Number: 1447143
Register: Principal
Mark Type: Trademark
Status: The registration has been renewed.
Status Date: Jun. 18, 2007
Publication Date: Apr. 21, 1987
Application Filing Date: Sep. 30, 1986
Registration Date: Jul. 14, 1987

Mark Information

Mark Literal Elements: EMITEC
Standard Character Claim: No
Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Foreign Information

Priority Claimed: Yes
Foreign Application Number: J20866/7WZ
Foreign Registration Number: 1095950
Foreign Application/Registration Country: GERMANY
Foreign Application Filing Date: Apr. 07, 1986
Foreign Registration Date: Sep. 03, 1986
Foreign Expiration Date: Apr. 07, 1996

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *...* identify additional (new) wording in the goods/services.

For: CATALYTIC CONVERTERS AND MOUNTING UNITS FOR INTERNAL COMBUSTION ENGINES FOR INDUSTRIAL AND AGRICULTURAL USE AND FOR NON-LAND VEHICLES

International Class(es): 007 - Primary Class

U.S Class(es): 023

Class Status: ACTIVE

Basis: 44(e)

For: CATALYTIC CONVERTERS AND MOUNTING UNITS FOR INTERNAL COMBUSTION ENGINES FOR LAND VEHICLES

International Class(es): 012 - Primary Class

U.S Class(es): 019, 023

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: Yes

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: Yes

Amended 44E: Yes

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: EMITEC GESELLSCHAFT FUR EMISSIONSTECHNOLOGIE MBH

Owner Address: HAUPSTRASSE 128
D-53797 LOHMAR
GERMANY

Legal Entity Type: CORPORATION

State or Country Where
Organized: GERMANY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: LAWRENCE E. ABELMAN

Docket Number: 941431

Correspondent

Correspondent Name/Address: LAWRENCE E. ABELMAN
ABELMAN FRAYNE & SCHWAB
666 THIRD AVENUE
NEW YORK, NEW YORK 10017-5621
UNITED STATES

Phone: 212-9499022

Fax: 212-9499190

Domestic Representative

Domestic Representative Name: LAWRENCE E. ABELMAN

Phone: 212-9499022

Fax: 212-9499190

Prosecution History

Date	Description	Proceeding Number
Jun. 18, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	71378
Jun. 18, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jun. 13, 2007	ASSIGNED TO PARALEGAL	71378
May 18, 2007	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
May 18, 2007	TEAS SECTION 8 & 9 RECEIVED	
Mar. 19, 2007	CASE FILE IN TICRS	
Sep. 18, 2006	REVIEW OF CORRESPONDENCE COMPLETE	74215
Aug. 21, 2006	PAPER RECEIVED	
Aug. 10, 1993	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
May 03, 1993	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Jul. 14, 1987	REGISTERED-PRINCIPAL REGISTER	
Apr. 21, 1987	PUBLISHED FOR OPPOSITION	
Mar. 21, 1987	NOTICE OF PUBLICATION	
Feb. 03, 1987	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 28, 1987	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Jan. 28, 1987	EXAMINERS AMENDMENT MAILED	
Jan. 07, 1987	NON-FINAL ACTION MAILED	
Dec. 09, 1986	ASSIGNED TO EXAMINER	62514

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jul. 14, 2007

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Jun. 18, 2007